



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,576	11/21/2003	Heiko K. Sacher	MOTO0009	3260

22862 7590 07/08/2010  
GLENN PATENT GROUP  
3475 EDISON WAY, SUITE L  
MENLO PARK, CA 94025

EXAMINER
----------

PESIN, BORIS M

ART UNIT	PAPER NUMBER
----------	--------------

2174

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/08/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eptomatters@glenn-law.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,576	<b>Applicant(s)</b> SACHER ET AL.	
	<b>Examiner</b> BORIS PESIN	<b>Art Unit</b> 2174	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,16-20,25-29,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-11,16-20,25-29,35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This communication is responsive to the amendment filed 4/19/2010.

Claims 1, 5-11, 16-20, 25-29 and 35-36 are pending in this application. Claims 1, 25, and 35 are independent claims. In the amendment filed 4/19/2010, claims 1, 25, and 35 were amended. This action is made Final.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams (US 7155683).

With respect to claim 35, Williams teaches a portable electronic device comprising: a display for displaying a content string including one or more content elements (See Figure 9); a user input for entering the one or more content elements of the content string (See Figures 5 and 6); and a user interface coupled to the display and further coupled to the user input (See Figures 5 and 7), wherein the user interface is adapted to:

determine a most probable completion alternative (See Figure 9, Element 78);  
cause to the most probable completion alternative to be displayed (See Figure 9, Element 78);

and add the most probable completion alternative to the content string in response to receiving a signal from the user input that the user has accepted the most probable completion alternative, wherein the user interface comprises a navigation key having a first set of controls for acceptance or non-acceptance of a most probable completion alternative currently displayed at the display and a second set of controls for changing or overriding the most probable completion alternative currently displayed at the display (See Column 6, Lines 43-52 and Column 7, Line 43 – Column 8, Line 14, additionally see Figures 6 and 8 Elements 72 and 73. These elements are part of the same graphical user interface key and are subject to various controls. The Applicant's claims do not specify that the key is a physical key.)

With respect to claim 36, Williams teaches the portable electronic device of claim 35, wherein: the first set of controls includes first and second controls at opposing positions of the navigation key; and the second set of controls includes third and fourth controls at opposing positions of the navigation key different from the positions of the first and second controls (See Column 6, Lines 43-52 and Column 7, Line 43 – Column 8, Line 14 and Figures 5 and 7 where all the buttons are opposing one another).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 5-10, 16-20, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comer et al. (US 5,845,300) in view of Bodnar et al. (US 6310634).

In regards to claim 1, Comer teaches a method of operating an electronic device comprising the steps of: initiating entry of a content string by receiving a first key selection input, said first key corresponding to a first set of textual characters (See Abstract); determining a most probable completion alternative using a database, said completion alternative being either (a) a most probable character selected from said first set of textual characters or (b) a most probable sub-string, said sub-string beginning with said most probably character and including at least one additional character (See Abstract); displaying the most probable completion alternative in a content string entry line of a display of said electronic device (See Abstract); receiving a second input, said second input being either a second key corresponding to a second set of textual character or a selection key (See Abstract); and adding the most probable completion alternative to the content string entry line of said for said second input being said selection key and said most probable completion alternative being the

Art Unit: 2174

most probable sub-string, and adding a second completion alternative for said second input being said second key, said second completion alternative being a most probable second sub-string, said second sub-string beginning with said most probable first character and including said most probable second character and at least a most probable third character (See Figures 3a-3j and accompanying text is the specification).

Comer does not teach determining a most probable completion alternative using a personalized and learning database. Bodnar teaches, "By remembering what the user has previously inputted and by using context-sensitive menus and adaptive "quick" lists, the system can anticipate what the user needs to do at any given time and can guide the user through a step-by-step process to complete each task, thus facilitating the tasks that users most often perform." (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Comer with the teachings of Bodnar and include a learning database with the motivation to provide the user with a faster method of inputting words in the system.

In regards to claim 5, Comer and Bodnar teach the method of operating an electronic device as defined in claim 1, further comprising the steps of: detecting a user input for going back in the content string after the adding step; and eliminating the most probable completion alternative from the content string (Comer Column 11, Lines 1-16).

In regards to claim 6, Comer and Bodnar further teach a method of operating an electronic device as defined in claim 5, wherein the user input comprises a user

Art Unit: 2174

pressing a left control of a navigation key (See Figure 1, Element 28, the keyboard has arrow keys for moving left and right).

In regards to claim 7, Comer and Bodnar teach the method of operating an electronic device as defined in claim 1 wherein the database comprises recently used data selected from a group consisting of one or more new words, one or more word associations, one or more context associations, one or more sensitivity associations, one or more Uniform Resource Locators, and one or more electronic mail addresses ("By remembering what the user has previously inputted and by using context-sensitive menus and adaptive "quick" lists, the system can anticipate what the user needs to do at any given time and can guide the user through a step-by-step process to complete each task, thus facilitating the tasks that users most often perform." Bodnar, Abstract).

In regards to claim 8, Comer and Bodnar teach the method of operating an electronic device as defined in claim 1, further comprising the steps of: dismissing the most probable completion alternative when the user does not accept the most probable completion alternative; and displaying a next most probable completion alternative (Bodnar Figure 1A, Element 104).

In regards to claim 9, Comer and Bodnar teach the method of operating an electronic device as defined in claim 1, further comprising the steps of: overriding the most probable completion alternative by a user input; and displaying a next most probable completion alternative (Bodnar Figure 1A, Element 104).

In regards to claim 10, Comer and Bodnar teach the method of operating an electronic device as recited in claim 9, wherein the step of overriding comprises: the

Art Unit: 2174

user pressing a first set of controls of a navigation key to indicate the overriding; and the user pressing a second set of controls of the navigation key to scroll through one or more completion alternates (Bodnar Figure 1A, Element 103).

Claim 25 is similar in scope to claim 1; therefore it is rejected under similar rationale.

In regards to claim 26, Comer and Bodnar teach a portable communication device (See Figure 1, the computer is interpreted to be a laptop) as defined in claim 25 wherein the user input comprises: a navigation key having at least two control keys (See Figure 1), wherein a first control key provides for accepting of the most probable completion alternative (See Figures 3a-3j and accompanying text is the specification).

In regards to claim 27, Comer and Bodnar teach a portable communication device as defined in claim 26 wherein a second control key provides for removing the added most probable completion alternative from the content string (See Figure 3d)

In regards to claim 28, Comer and Bodnar teach a portable communication device as defined in claim 27 wherein a third control key provides for requesting a next most probable completion alternative (See Figures 3a-3j and accompanying text is the specification, as the user types further various completion alternatives will be displayed).

In regards to claim 29, Comer and Bodnar teach a portable communication device as defined in claim 27 wherein a third control key provides for overriding the most probable completion alternative (See Figure 3d), and further wherein a fourth



Art Unit: 2174

control key provides for scrolling through one or more completion alternates (Bodnar Figure 1A, Element 103).

Claims 11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Bodnar et al. (US 6310634) further in view of Simpson et al. (US 2004/0153963).

In regards to claim 11, Comer-Bodnar do not specifically teach identifying as part of said most probable completion alternative, a most probable phrase consisting of at least a first word and a second word, said first word and said second word corresponding to a phrase stored in said personalized and learning database; displaying the most probable phrase in said content string entry line of said display; and receiving a third input accepting said most probable phrase; and adding the most probable phrase to the content string entry line of said display in response to receiving said third input.

Simpson teaches identifying as part of said most probable completion alternative, a most probable phrase consisting of at least a first word and a second word, said first word and said second word corresponding to a phrase stored in said personalized and learning database; displaying the most probable phrase in said content string entry line of said display; and receiving a third input accepting said most probable phrase; and adding the most probable phrase to the content string entry line of said display in response to receiving said third input (See Paragraph 36 and 47). It would have been

Art Unit: 2174

obvious to one of ordinary skill in the art at the time of invention to modify Comer-Bodnar with the teachings of Simpson and include phrase completion capability with the motivation to provide the user with a simpler method of entering multiple words.

In regards to claim 16, Comer-Bodnar-Simpson teach all the limitations of claim 11. They further teach a method wherein said phrase includes at least three words and has a maximum number of words and wherein the user accepts at least two words but less words than said maximum number of words (Simpson See Paragraph 36 and 47).

In regards to claim 17, Comer-Bodnar-Simpson teach all the limitations of claim 11. They further teach a method wherein the user accepts the entire most probable phrase (Simpson See Paragraph 36 and 47).

In regards to claim 18, Comer and Bodnar teach all the limitations of claim 1. Comer-Bodnar-Simpson further teach the step of: editing the most probable next phrase (Simpson See Paragraph 36 and 47).

In regards to claim 19, Comer-Bodnar-Simpson teach all the limitations of claim 18. They further teach a method wherein the editing step comprises pressing a control of a navigation key to move the focus to a next word of said phrase and comparing the next word to one or more word alternates, said word alternates being part of a phrase alternate (Simpson See Paragraph 36 and 47).

In regards to claim 20, Comer-Bodnar-Simpson teach all the limitations of claim 11. They further teach a method further comprising the steps of: retrieving one or more phrases from the personalized and learning database (Simpson See Paragraph 36 and

Art Unit: 2174

47); displaying the one or more alternate phrases (Simpson See Paragraph 36 and 47); and reviewing the one or more alternate phrases by a user using one or more controls of a navigation key (Simpson See Paragraph 36 and 47).

### ***Response to Arguments***

Applicant's arguments filed 4/19/2010 have been fully considered but they are not persuasive.

In regards to the Applicant's argument that Williams does not teach a single key that has various controls, the Examiner respectfully disagrees. Williams teaches that elements 72 and 73 of Figures 6 and 8 are part of the same graphical user interface key and are subject to various controls. The Applicant's claims do not specify that Applicant's key is a physical key. The Examiner suggests that the Applicant amend the claim language to clarify that the key is a physical part of the mobile device.

Applicant's arguments with respect to claims 1, 5-11, 16-20, and 25-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2174

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BORIS PESIN whose telephone number is (571)272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571)272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Boris Pesin/  
Primary Examiner, Art Unit 2174